



REPLY BRIEF
U.S. Application No. 09/441,204
Attorney Docket No.: 56490.000002

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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| In re Patent Application of: |) | Attorney Docket No. 56490.000002 |
| |) | |
| David VERCHERE |) | Confirmation No. 3995 |
| |) | |
| Serial Number: 09/441,204 |) | TC/A.U.: 3625 |
| |) | Examiner: Robert M. Pond |
| Filed: November 16, 1999 |) | |
| |) | Customer No. 21967 |

**For: METHOD AND SYSTEM FOR ACQUIRING BRANDED PROMOTIONAL
PRODUCTS**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

This is Appellant's Reply Brief responsive to the Examiner's Answer mailed May 16, 2005, in connection with the above-captioned patent application. Appellant presents this brief to clarify points raised by the Examiner in the Examiner's Answer.

Appellant believes that there is no fee required for the submission of this Reply Brief. However, the Commissioner is hereby authorized to charge Deposit Account No. 50-0206, if deemed necessary.

I. The Examiner's Rejection under 35 U.S.C. § 101 is Improper and Baseless

The Examiner alleges that the terms module, interface and database have manual equivalents in business methods. More specifically, the Examiner alleges that "interface" refers

to products viewable on shelves in a warehouse to a paper catalog for consumer viewing; “module” refers to separate delineated section of a paper catalog; and “database” refers to a card file or paper folder containing information about a customer. Appellants asserts that the Examiner has misinterpreted the claims and improperly construed the claims in a manner inconsistent with the specification and the claim language itself. The definitions applied by the Examiner are not supported in Appellant’s specification. In fact, the definitions are contrary to the claim language. More specifically, the claims recite “computer implemented” - the Examiner has conveniently ignored this claim recitation. Further, the definitions applied by the Examiner have no support in Appellant’s specification. Appellants clearly show a computer implemented system and method, as supported in the specification, drawings and claim language. It is clear that the Examiner is applying improper, completely unsupported, definitions to the claim language, while ignoring the specification, drawings as well as claim language.

II. The Examiner Improperly Interprets Claim Limitations

The Examiner’s combination of Conklin and Promomart completely fails to render the claimed inventions obvious. More specifically, with regards to independent claims 10 and 20, the claimed invention provides multiple levels of interaction through different entry points. In other words, the claimed inventions provide a multi-level network among sellers, resellers and vendors whereas Conklin is limited to only a bi-level network between buyers and sellers. In terms of claim language, Conklin fails to disclose at least *a vendor entry point interface*, *a reseller entry point interface*, and *a reseller customer entry point interface*, as recited in independent claims 21 and 26. In addition, Conklin fails to disclose at least *a products web*

page, a reseller showcase web page, a vendor showcase web page, as recited in independent claims 10 and 20.

In addressing the multi-level network of the claimed inventions, the Examiner alleges that Conkin's multi-level network comprises public internet, private intranets and extranets used to extend a company's private intranet (see page 4, Examiner's Answer). However, this excerpt fails to show the claimed distinct entry points for different participants. Rather, the excerpt relied upon by the Examiner merely discusses different information exchange platforms with no regard for different entry points for different participants.

Further, the Examiner continues to apply multiple meanings to single elements of Conklin to improperly meet multiple distinct and different claim limitations (page 5, Examiner's Answer). Office Action alleges that Conklin's disclosure of sellers meets the claim limitation of not only vendors, but also resellers. However, by applying the overly broad definition proposed by the Office Action, the Examiner has combined two distinct limitations into a single element thereby improperly eliminating the entire reseller limitation in the claims. The overly broad definition of "reseller" suggested by the Office Action contradicts the definition provided by the claim language itself where the claims define customers, resellers and vendors as distinct participants. Further, the claims recite distinct entry points for vendors, resellers and customers. Thus, the definition applied by the Office Action is improper. Properly interpreting vendors, resellers and customers as distinct participants, Conklin's bi-level system of sellers and buyers clearly fails to meet the claimed invention of a multi-level network involving resellers, vendors and customers.

Similarly, the Examiner misinterprets the Promomart reference to include features with absolutely no support in the disclosure. The Promomart website (see pages 6-7 and pages 10-11) fails to provide any mention or suggestion of the discrete entry points as claimed by Appellant. In contrast to the claimed inventions, Promomart appears to disclose an online database shopping cart that is routed to a retailer where a consultant may be selected. By selecting a product category, Promomart appears to provide a list of vendors from which products matching the category may be purchased from. The resulting page, as shown on page 16 of Promomart, is merely a list of consultants from whom products may be purchase. Therefore, Promomart is more akin to a referral service. Promomart clearly fails to disclose discrete entry points for different participants, such as vendors, resellers, and customers. Rather, there is no distinction of different participants in Promomart and all users appear to enter and access Promomart in the same manner. Therefore, different participants are unable to manage and enter data specific to their roles, as provided by the system and method of the present inventions.

On pages 5 and 6 of the Examiner's Answer, the Examiner alleges that Promomart shows discrete entry points by relying upon Promomart's electronic links. The electronic links are results of a search query where each link is for a vendor that matches the search criteria. The Examiner has failed to explain how an electronic link to a vendor on a search result page could possibly be interpreted as the claimed discrete entry points. This is yet another example of the Examiner's misinterpretation of claim elements with a complete disregard for what the reference actually discloses.

By ignoring positively recited limitations, the Examiner has improperly misconstrued the claims and applied references that fail to render the claimed inventions obvious. The applied combination fails to teach the embodiments of the claimed inventions.

III. The Examiner's Proposed Combinations are Fundamentally Flawed

Independent claims 10 and 20 are currently rejected under the Conklin and the Promomart website combination. Independent claims 21 and 26 are currently rejected under the Conklin, Promomart website and Busch article combination. The remaining dependent claims inherently contain the limitations of the corresponding independent claim.

On page 6 of the Examiner's Answer, the Examiner alleges that the Appellant confuses "hindsight reconstruction with creative uses for the Conklin invention." The statement is a clear example of the improper application of the cited references. The standard for a proper rejection under 35 U.S.C. § 103 is whether the combination would have been obvious to one of ordinary skill in the art at the time of the invention, not whether a reference can be applied or modified in a creative manner as suggested by the Examiner. The Examiner's "creative uses" standard implies a use of the reference that is not within the level of ordinary skill in the art but rather a use that would require skills outside the realm of "ordinary skill." In addition, by applying a "creative use" standard, the Examiner is not relying upon a teaching from the reference itself but is rather fabricating an application that is not obvious from the reference or readily foreseeable to one of ordinary skill in the art. In applying the Examiner's "creative uses," the Examiner conveniently ignores the proper standard for combining references and applies a new improper standard that is contrary to law.

In combining the Conklin and Promomart references, the Examiner summarily concludes that “Conklin and Promomart in combination teach and/or suggest an online community of participants engaged in the buying and selling of branded promotional products.” (page 6, Examiner’s Answer). Aside from the fact that Conklin fails to show the claim limitations, what is fundamentally lacking in this analysis is any indication in any of the prior art that implementing a branded promotional community is a problem that needs to be solved or could be solved by the referral system of Promomart. This statement of motivation is a clear example of improper hindsight.

Controlling Federal Circuit and Board precedent require that the Office Action set forth specific and particularized motivation for one of ordinary skill in the art to modify a primary reference to achieve a claimed invention. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000) (“[t]o prevent a hindsight-based obviousness analysis, [the Federal Circuit has] clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references.”).

Here, there has been no citation of any teaching anywhere in the art of any need for the multiple entry points. The Examiner, throughout the prosecution history, has failed to identify any teaching of that problem specifically. The Examiner has also failed to rely on any teaching from the Promomart reference that would motivate one of ordinary skill in the art to modify the Conklin reference. The Examiner not only misinterprets what Promomart actually discloses but also fails to provide a proper statement of motivation for combining at least these two disparate references. More specifically, Conklin purports to show a system for iterative multivariate

negotiations over a bi-level network (Abstract of Conklin) while Promomart purports to show a “directory of consultants” (page 2 of the Promomart reference). When a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz*, 234 F.3d at 664. In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention. Because such a proper motivation to combine is missing, the combinations are improper and the rejections should be overturned.

If the approach taken by this Examiner were adopted, in almost every instance, some reason for a modifying a reference could be created by the Examiner unrelated to any actual problem recognized in the art. It is the requirement that the motivation to solve a recognized problem be from the teachings of the art that keeps the application process honest to the goal of avoiding hindsight reconstruction. Indeed, the very key aspect in determining obviousness should be that there is a clear nexus between the teachings in the art as to the deficiencies in a particular way of doing things and a solution provided by the supplemental references.

Finally, the Examiner appears to argue that because Promomart discloses branded promotional products, it would have been obvious to modify Conklin to provided branded promotional products. This alleged statement of motivation is improper and a clear example of improper hindsight. If the Office were permitted to make such generalizations of art, almost every proposed combination could be supported by modifying a reference for the purpose of

modifying the reference. Again, the absence of a teaching is the fundamental problem with the rejections proposed by the Examiner and the reason why these combinations are improper. Therefore, there must be some motivation to combine the elements besides for the sake of combining the references.

In addition, even if the references could be combined as proposed by the Examiner, the resulting combination would nevertheless fail to render the claim inventions obvious.

III. The Examiner Has Failed To Meet The Burden Of Proof

Under U.S. law, an inventor is entitled to a patent for any invention that is new, useful, and non-obvious. 35 U.S.C. §101-103. The Answer has not presented a *prima facie* case of non-obviousness by which to deny a patent to Appellant. Rather than providing statements of motivation as taught by the references, the Examiner lists selective features without providing any reasoning as to why one of ordinary skill in the art would have been motivated to combine three disparate references. The Examiner summarily concludes that the claim limitations are met without ever explaining why one of ordinary skill in the art would (1) combine the disparate references and (2) how the resulting combination meets the claimed inventions. Even if the references could be combined as suggested by the Examiner, the resulting combination would nevertheless fail to teach the combination of claim limitations recited by Appellant.

CONCLUSION

For at least the foregoing reasons, the rejections of claims 10 and 20-36 should be reversed.

Respectfully submitted,

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